

REMARKS/ARGUMENTS

Claim Rejections - 35 USC §102

1. The Examiner rejected claims 1, 2, and 4 under §102(b) as being anticipated by Benson.

2. Applicant has amended claim 1 to more clearly state how the elements of the claimed embodiment are used. These elements are not shown in the prior art. Support for these amendments can be found on page 2, ll. 24-28 of the application.

3. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

4. Claim 1 has been amended to include the limitation that the bag support and liner be configured with a locking mechanism that engages and disengages when in use, whereby the locking mechanism would be engaged, the bag would be slid over the bag support, and then the locking mechanism would be disengaged, thereby causing the liner to expand and conform to the shape of the bag. Benson does not show this structure. Benson further teaches away from this structure in providing adjustable locking tabs allowing the liner to be configured for use with various shapes and sizes of bags and to conform to the mouth of such a bag. No mention in Benson is made of releasing the tube after being made. For this reason, Benson does not anticipate the present invention in claim 1 or any of the claims that depend there from.

Claim Rejections - 35 USC §103

5. The Examiner rejected claim 3 under §103(a) as being unpatentable (obvious) over Benson in view of Monahan.

6. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

7. It is submitted that the combination of Benson and Monahan is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of

features recited in applicant's claims. In particular, the references do not disclose, teach, or suggest Applicant's locking means which is engaged when the bag is installed, but disengaged and expands after the bag is installed.

8. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

9. This can be illustrated as why a device that is intended to be utilized when formed as a tube (Benson) would be combined piecemeal with a device intended to be utilized when unrolled (Monahan). These two patents teach away from each other.

10. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicant's specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." [citations omitted]

In re Fritch, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

11. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore &*

Assoc. v. Garlock, Inc. 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). That is exactly what the Examiner is doing here.

12. Benson and Monahan are complete and functional without the need for modification. Absent the need for modification to provide functionality, the references could never lead one to make modifications to meet the claims.

13. The initial burden is on the Examiner to provide some **suggestion** of the desirability of doing what the inventor has done.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly **suggest** the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”

Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. and Inter. 1985). MPEP § 706.02(j) (emphasis added).

14. This suggestion for modification must be **motivating**.

“The prior art must provide one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.”

In re Jones, 21 USPQ2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

15. Even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the **desirability** for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (“mere fact that prior art may be modified to reflect features of claimed invention does not make the modification, and hence, the claimed invention, obvious unless the desirability of such a modification is suggested by prior art). Citing *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.

16. Moreover, the motivating suggestion must also be **explicit**. An invention cannot be found obvious unless there is “some **explicit** teaching or suggestion in art to motivate one of even ordinary skill to combine such elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1140 (D.C.D.C. 1998).

17. The Examiner’s suggested combination is not explicit, nor is it motivated, suggested, or even desirable. No prima facie case of obviousness has been made.

18. Benson is clear that the locking means is intended to lock the opener into a fixed shape for use. Otherwise there would be no reason to provide for adjustability in allowing the opener to be locked into a desired circumference. Additionally, Benson is clear that the opener is in "cylindrical form and so retained in locked snugly conforming position during the filling thereof." These two references clearly teach away from one another.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 23RD day of February 2004.

Very respectfully,



STEPHEN M. NIPPER

Reg. No. 46,260

(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DATE:

2/23/04

Shannon M. Wilson

